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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant : Joerg-Michael HASEMANN
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For : TELECOMMUNICATION TERMINAL HAVING
CHARACTER RECOGNITION
Examiner : Nhan T. LE
Art Unit : 2618
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APPELLANT'S REPLY BRIEF
UNDER 37 C.F.R. § 41.41

S I R :

In response to the Examiner's Answer mailed on May 10, 2006,
Applicant submits this Reply Brief in support of his appeal.

I. ARGUMENTS

A. Rejection of Claims 12-25 and 27-29 under 35 U.S.C. § 103(a)

Claims 12-25 and 27-29 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,487,421 ("Hess") in view of U.S. Patent No. 6,081,261 ("Wolff") and in further view of U.S. Patent No. 4,751,741 ("Mochinaga").

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The prior art must suggest combining the features in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296; In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In the "Response to Argument" section of the Examiner's Answer, the Examiner contends that the applied prior art references provide the requisite motivation for combining the elements in the manner contemplated by

claim 12 because **“all references (Hess, Wolff and Mochinaga) teach the pen-like device that includes entry data input unit with one pressure sensor element, a pressure receiving element acting jointly with the pressure sensor element so that the movement of pressure receiving element is detected by the pressure sensor element.”** (Examiner’s Answer, p. 9). However, the actual teachings of Hess clearly contradict the Examiner’s assertion that all three of the applied references (Hess, Wolff and Mochinaga) teach **“the pen-like device that includes entry data input unit with one pressure sensor element, a pressure receiving element acting jointly with the pressure sensor element so that the movement of pressure receiving element is detected by the pressure sensor element.”** Hess teaches that a pressure applied to the tip element 14 results in an identification signal sent via line 16 to the circuit 3, which contains a recognition device 21. (Col. 5, l. 37-40 & 43-48). In addition, Hess teaches that acceleration signals measured by the motion detector 10 are sent to the recognition device 21 via line 13. (Col. 5, l. 48-50). Accordingly, the **signal resulting from the pressure on the tip element 14 is completely separate from, and has nothing to do with, the acceleration signal from the motion detector 10**, and therefore Hess clearly does not teach **“the pen-like device that includes entry data input unit with one pressure sensor element, a pressure receiving element acting jointly with the pressure sensor element so that the movement of pressure receiving element is detected by the pressure sensor element.”** Therefore, it is patently false to assert that **“all references (Hess, Wolff and Mochinaga) teach the pen-like device that includes entry data input unit with one pressure sensor element, a pressure receiving element acting jointly with the pressure sensor element so that the movement of pressure receiving element is detected by the pressure sensor element.”**

Even if one assumed for the sake of argument that “all references (Hess, Wolff and Mochinaga) teach the pen-like device that includes entry data input unit with one pressure sensor element, a pressure receiving element acting jointly with the pressure sensor element so that the movement of

pressure receiving element is detected by the pressure sensor element,” which is clearly false, this assumption still would not provide sufficient basis for concluding that one of ordinary skill in the art would be motivated to selectively combine the particular elements of the applied references in the manner asserted by the Examiner. First, the assumption that the applied references may have a common feature does not in any way suggest that selected components from each applied reference may be randomly combined to achieve the claimed subject matter. Second, the Examiner’s assumption regarding the applied references, i.e., “all references (Hess, Wolff and Mochinaga) teach the pen-like device that includes entry data input unit with one pressure sensor element, a pressure receiving element acting jointly with the pressure sensor element so that the movement of pressure receiving element is detected by the pressure sensor element,” simply ignores the fact that the overall teachings of each individual reference are clearly different from the overall teachings of the other combined references, i.e., in contrast to Hess (which teaches a mobile radio telephone), neither Wolff nor Mochinaga relates to a telecommunication device.

In paragraph 2 of the “Response to Argument” section of the Examiner’s Answer, the Examiner further contends that the incorporation of selected elements from Wolff and Mochinaga would be obvious because Wolff and Mochinaga teach the selected elements. However, merely listing what each applied reference teaches does not satisfy the requirement for establishing obviousness, i.e., there must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000), and a *prima facie* finding of obviousness requires a suggestion to combine the references that is “clear and particular.” In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

In paragraph 4 of the “Response to Argument” section of the Examiner’s Answer, the Examiner additionally contends that “the combination of Wolff and Mochinaga with Hess would not change the operation of Hess,” since “all three references operate with one purpose using a pen-like instrument to sense and recognize characters.” However, even if one assumes for the sake of argument that all three references may indeed share a common feature (with which assumption Applicant does not agree), this assumption doesn’t have any relevance to the issue of whether a particular modification would change the principle of operation of the reference being modified and/or render the system of the reference being modified unsatisfactory for its original intended purpose. As noted above, Hess teaches that a pressure applied to the tip element 14 results in an identification signal sent via line 16 to the circuit 3, which contains a recognition device 21, (col. 5, l. 37-40 & 43-48), and Hess further teaches that acceleration signals measured by the motion detector 10 are sent to the recognition device 21 via line 13. (Col. 5, l. 48-50). Accordingly, the **signal resulting from the pressure on the tip element 14 of Hess is completely separate from, and has nothing to do with, the acceleration signal from the motion detector 10.** Therefore, the asserted incorporation of the alleged teachings of Wolff regarding the pressure receiving element acting jointly with a pressure sensor element would clearly change the principle of operation of Hess, thereby rendering the obviousness conclusion incorrect as a matter of law. (See, e.g., MPEP 2143.01 (citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); and In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959)).

With respect to the Examiner’s contention in paragraph 5 of the “Response to Argument” section of the Examiner’s Answer, i.e., “the combination of Hess, Wolff and Mochinaga is not based on hindsight reconstruction since all references disclose pen-like instrument to sense and recognize character based on the pressure sensor element,” this assertion is a self-serving conclusion that is entirely irrelevant to the obviousness analysis. Even if one assumes for the sake of argument that indeed “all references

disclose pen-like instrument to sense and recognize character based on the pressure sensor element," such assumption would have no relevance to the issue of why and how one of ordinary skill in the art would selectively pick certain components from each applied reference and selectively combine them in an attempt to achieve the present claimed invention.

For at least the foregoing reasons, Applicant submits that the obviousness rejection of independent claim 12 and its dependent claims 13-25 and 27-29 should be reversed.

B. Rejection of Claim 26 under 35 U.S.C. § 103(a)

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,487,421 ("Hess") in view of U.S. Patent No. 6,081,261 ("Wolff"), U.S. Patent No. 4,751,741 ("Mochinaga") as applied to claim 15 above and further in view of U.S. Patent No. 6,104,388 ("Nagai").

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The prior art must suggest combining the features in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296; In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of

inherent disclosure to support the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In support of the rejection of claim 26, the Examiner simply repeats in the Examiner’s Answer the arguments contained in the final Office Action of February 23, 2005. In addition, in the “Response to Argument” section of the Examiner’s Answer, the Examiner states that “[t]he same argument is applied as to claim 12 above.” As discussed in connection with base claim 12, on which claim 26 ultimately depends, the overall teachings of Hess, Wolff and Mochinaga references do not provide any objective motivation for selectively combining the individual teachings in the manner suggested by the Examiner. The addition of Nagai clearly fails to remedy the deficiencies of the asserted combination of Hess, Wolff and Mochinaga as applied against base claim 12, i.e., the overall teachings of Hess, Wolff, Mochinaga and Nagai do not provide any objective motivation for making the selective combination asserted by the Examiner. At best, the Examiner has merely listed another reference that shows a particular component of the claimed invention, but the Examiner has not provided any “clear and particular” suggestion for the asserted combination with the other applied references. Since a *prima facie* finding of obviousness requires a suggestion to combine the references that is “clear and particular,” and since the Examiner has not provided any “clear and particular” suggestion for the asserted combination, the Examiner has not established a *prima facie* finding of obviousness. See In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

For the foregoing reasons, the obviousness rejection of claim 26 should be reversed.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the final rejection of claims 12-29 should be reversed.

While no fees are believed to be due in connection with this paper, the Office is authorized to charge any fees deemed necessary in connection with this paper to Deposit Account No. **11-0600** of Kenyon & Kenyon LLP.

Respectfully submitted,

KENYON & KENYON LLP

 (R. No. 36,197)

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